

## **REMARKS**

The Final Office Action dated August 4, 2009 has been reviewed, and the comments of the U.S. Patent Office have been considered. Claim 29 has been cancelled, Claims 30 and 31 have been amended and claims 31 - 34 are withdrawn from consideration.

### **Election/Restrictions**

Claims 31-34 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicants respectfully request reconsideration. While Applicant acknowledges that a polypeptide like that claimed in Claim 30 has a different amino acid structure than an antibody, as argued in the outstanding office action, that really has nothing to do with the issue of propriety of restriction. Either the claims are drawn to patentably distinct inventions, in which case restriction is appropriate, or it's not. There is a further requirement to support restriction herein, however. Restriction is never appropriate when searching all the claimed subject matter would not impose an undue burden.

The Examiner has previously argued that a polypeptide and its antibody are not patentably distinct. If it is now the Examiner's position that they ARE patentably distinct, that is fine. The record should reflect the Examiner's position.

Nor would searching for the antibody binding to the polypeptide involve an undue burden. They are bound to be discussed together. An antibody is characterized by the polypeptide it binds to. Any search would be trivial. In the outstanding office action, the Examiner neither indicates Claims 29 and 30 to be directed to subject matter patentably distinct from Claims 3 - 34, nor does she indicate why it would be an undue burden to search for both.

The fact that they share different classifications does not create, without more, a serious burden in searching.

The restriction requirement is respectfully traversed.

**Priority**

The Examiner's argument elevates form over substance. While it is believed that the Examiner's position that Claim 30 is not entitled to the benefit of U.S. Patent Application Serial No. 08/585,758, filed January 12, 1996 is mooted by amendment, a few observations are appropriate.

As patent applications were increasingly filed directed to sequences of amino acids and nucleotides, the patent office developed rules, 37 C.F.R. §§1.823 – 825, for the presentation of these sequences in a computer readable format and to present simplified claims based on the sequences provided. These rules were developed after the priority date of the current application. Complying with them does not somehow infuse this application with new matter. A claim directed to a sequence of amino acids that is carved out of SEQ ID No. 4, residues 11 – 390, does not somehow introduce the requirement that the amino acid sequence have been described as carved out of an amino acid sequence that is 390 residues long. It is simply another, better way, of describing the bases that are lined up, one after another, in 380 bases, in the primary structure of the polypeptide.

Nonetheless, this is the basis for the Examiner's rejection. It is the position of the Examiner that reciting "the sequence of amino acids 11 – 390 of SEQ ID No. 4" somehow requires the grandparent application to convey to those of ordinary skill in the art that the amino acid sequence is 390 amino acids long. Such is simply not the case.

In any event, the issue is moot. Applicants have amended Claim 30 to recite, in sequence form, the EXACT sequence disclosed in the grandparent case. No reference to amino acid 11 or amino acid 390 is made. This specific sequence was recited in the original filing, and every filing included in the priority chain of this case, including U.S. Patent Application Serial No. 08/585,758, filed January 12, 1996. As this effective filing date is earlier in time than the references relied upon, no inspection of the earlier filed application, which has the same sequence, is required. Claim 30 finds support, *ipseissimis verbis*, in every application in the priority chain of this application, back to January 12, 1996. Acknowledgment of Applicants' priority is respectfully requested.

**Claim Rejections – 35 U.S.C. § 102**

Claims 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by GenBank Accession No U8213 (04-Jun-1998). This rejection is moot. Applicants' Claim 30 is entitled to a priority date of at least January 12, 1996. The reference is not prior art under any section of 35 U.S.C. 102. Withdrawal of the rejection is respectfully requested.

Claims 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,892,016 (Brie et al., 06-Apr-1999). This rejection is moot. Applicants' Claim 30 is entitled to a priority date of at least January 12, 1996. The reference is not prior art under any section of 35 U.S.C. 102. Withdrawal of the rejection is respectfully requested.

Claim 30 is not otherwise rejected, and is believed to be in condition for allowance.

## **CONCLUSION**

In view of the foregoing evidence and remarks, Applicants respectfully request reconsideration of this Application and the prompt allowance of at least Claim 30. Further, on that basis, Applicants request allowance of Claims 31 – 34..

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the undersigned to expedite prosecution of the application.

The Commissioner is hereby authorized by this paper to charge any fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0548.

Date: October 5, 2009

Respectfully submitted,

**Berenato, White & Stavish**

6550 Rock Spring Drive  
Suite 240

Bethesda, Maryland 200817

Telephone: (301) 896-0600

Facsimile: (301) 896-0607

CUSTOMER NO: 80308 or 28410

/Steven B. Kelber/  
Steven B. Kelber  
Attorney for Applicants  
Reg. No.: 30,073

Customer No. 80308